

REMARKS

Claims 15, 17, and 19-28 are currently pending in this application, as amended. Claims 32-33 have been cancelled. Claims 15, 17, 19, and 27 have been amended for clarification. Support for the amendments can be found, for example, at least in the original drawings; and in the original Specification at page 9, lines 3-26; and at page 10, line 29 through page 11, line 10. Accordingly, no new matter has been added by the amendments to the claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 15, 17, 19-28, and 32-33 was rejected by the Examiner under 35 U.S.C. § 103(a) as being obvious over International Patent Publication No. WO 02/072182 A1 (Glenord). The Examiner asserts that Glenord discloses all of the elements of claims 15, 17, 19-28, and 32-33 except for an inhibit member passing through the head of the piston through a slot. However, the Examiner asserts that it would have been obvious to modify Glenord such that the inhibitor member “was moved from the outside of the head of the piston, to be placed on the inside of the head of the piston,” for the reason that reversal of essential working parts requires only routine skill in the art. (See e.g., Office Action at p. 4). Claims 32-33 have been cancelled, and the subject matter thereof moved into the independent claims. Applicant respectfully requests that the rejection of amended claims 15, 17, and 19-28 be withdrawn for at least the following reasons.

Claims 15, 17, 19, and 27, as amended, call for a user to press on the inhibit member to advance the piston when the inhibit member is in the inhibit position, and to press the actuation head of the piston to advance the piston when the inhibit member is moved or displaced. For example, in Figs. 1-3 of the present application, it is shown that a user would press the inhibit member 34 in order to advance the piston 12 while the inhibit member 34 is in the inhibit position. The inhibit member 34 can thereafter, for example, be removed as shown in Fig. 6, in which case the user would press the actuator head 12 B of the piston in order to advance the piston. As another example shown in Figs. 7-8, the inhibit member 50 can be displaced and include a central opening 56 such that a user can press the actuator head 12B of the piston 12 in order to advance the piston 12. Glenord fails to disclose this feature of claims 15, 17, 19, and 27.

Referring to Figs. 1-8, Glenord discloses a syringe 10 having an inner barrel 12 with a needle 16 attached thereto. A plunger actuating rod 22 is depressed by applying thumb pressure to an end flange 34 of the rod 22. A limit catch 23 prevents further movement. (Page 6, lines 7-15). The limit catch 23 operates by having fingers 36 engage the end 19 of an outer barrel 11, wherein the fingers 36 move pivotally, severing a membrane 38 that holds arms 37 of the limit catch 23 inwardly. On withdrawal of the plunger rod 22, the arms 37 spring outwardly so that on the next depression of the plunger rod 22, the fingers 36 do not engage the end 19 of the outer barrel 11. (Page 5, line 24-page 6, line 6). As is plainly clear from Figs. 3-4, the second depression of the plunger rod 22 also occurs via pressing of the end flange 34.

Thus, the plunger rod in the Glenord syringe is advanced by pressing the end flange of the rod in both the first configuration, wherein the catch is active to prevent full advancement of the plunger rod, and in the second configuration, wherein the catch is inactive. In contrast, claims 15, 17, 19, and 27 all call for the piston to be advanced when the inhibit member is in the inhibition position, by the user pressing on the inhibit member itself, as opposed to the piston actuation head, which is an entirely separate element.

Accordingly, even if the Examiner's proposed modification to Glenord based on the reasoning of *In re Einstein* were proper, which Applicant does not admit, claims 15, 17, 19, and 27 still would not have been obvious because Glenord fails to teach or suggest the element of pressing on the inhibit member to advance the piston when in the inhibit position, and *In re Einstein* fails to compensate for this deficiency. Specifically, the necessary modifications to the syringe of Glenord are not a mere reversal of parts, but are instead substantial, particularly since the inhibit member of Glenord is entirely below the head of the piston and has no structural element that would allow a user to press to advance the piston. Withdrawal of the rejection is therefore respectfully requested.

Claims 20-26 are dependent upon claim 19. Applicant respectfully requests that the rejection of claims 20-26 be withdrawn due to at least their dependence on claim 19. Claim 28 is

dependent upon claim 27. Applicant respectfully requests that the rejection of claim 28 be withdrawn due at least to its dependence on claim 27.

CONCLUSION

In view of the foregoing Amendment and remarks, Applicants respectfully submit that the present application, including claims 15, 17, and 19-28, is in condition for allowance and such action is respectfully requested.

Dated: October 15, 2009

Respectfully submitted,


By _____

Martin G. Belisario
Registration No.: 32,886
PANITCH SCHWARZE BELISARIO & NADEL LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, Pennsylvania 19103
(215) 965-1303
(215) 965-1331 (Fax)
mbelisario@panitchlaw.com (E-Mail)

MGB/SEM
159630